

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kevin Woehr et al.
5 Assignee: B. Braun Melsungen AG
Title: SPRING CLIP SAFETY IV CATHETER
Serial No.: 10/734,931 Filed: December 12, 2003
Examiner: Phillip A. Gray Group Art Unit: 3767
Attorney Docket No.: 1131-13-PA-TD

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Board of Patent Appeals and Interferences
PO Box 1450
15 Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41 AND M.P.E.P. § 1208

Sir:

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In reply to the Examiner's Answer, which was mailed on December 30, 2008, Appellants hereby submit this Reply Brief under 37 C.F.R. § 41.41 and M.P.E.P. § 1208.

STATUS OF THE CLAIMS

Claims 1-22 and 33-47 are pending in the application. Claims 23-32 have been canceled. Claims 1-22 and 33-47 stand rejected in the final Office action mailed on April 8, 2008. Appellants appealed Claims 1-22 and 33-47 pursuant to the Notice of Appeal filed on June 23, 5 2008 and Appellants' Brief filed on August 26, 2008. However, as detailed below, Appellants hereby withdraw Claims 1-9, 11-18 and 38-47 from appeal. Accordingly, only Claims 10, 19-22 and 33-37 are before the Board.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

In the Brief filed on August 26, 2008, Appellants argued that the first issue before the Board is whether the recitation of "dimension" in Claim 1 is unclear. Appellants' Brief (Apps' Br.), 3:28-29.¹ In the Examiner's Reply, the Examiner has withdrawn the objection to Claim 1. Examiner's Answer (Ex's Ans.), para. 6, pp. 2-3 and para. 10, pp. 5-6. Accordingly, this issue is not before the Board.

Appellants hereby withdraw Claims 1-9, 11-18 and 38-47 from appeal. Accordingly, the only issue before the Board is whether the subject matter of Claims 10, 19-22 and 33-37 is unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 4,929,241 to Kulli in view of U.S. Patent No. 5,215,528 to Purdy et al. ("Purdy") and further in view of U.S. Patent No. 5,549,570 to Rogalsky.

¹ References to Appellants' Brief herein follow the format of "page:line numbers." For example, the reference to Apps' Br., 3:28-29 refers to Appellants' Brief at page 3, lines 28 through 29.

APPELLANTS' ARGUMENTS

Rejections Under Kulli in View of Purdy and Further in View of Rogalsky

At pages 3-5 (paragraph 9) of the Examiner's Answer, the Examiner reasserts that Claims 1-22 and 33-47 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kulli in view of Purdy and further in view of Rogalsky. Ex's Ans., para. 9, pp. 3-5. These same rejections appeared in the final Office action. The Examiner then argues, at pages 6 and 7, that "Kulli and Rogalsky disclose and teach 'first and second arms that **intersect** one another at their second arm sections.'" (emphasis in original) The Examiner further argues, at pages 7 and 8, that it would have been obvious to one of skill in the art to have combined the teachings of Kulli, Purdy and Rogalsky.

Appellants respectfully disagree with the Examiner's arguments presented at pages 6-8 of the Examiner's Answer. For example, the Examiner's overly broad interpretation of the structures in Kulli and Rogalsky as intersecting distorts reality. Further, the Examiner uses the word intersect in a manner inconsistent with its definition, and applies an inappropriate context of that word to the present situation. Nevertheless, in order to expedite allowance of this application, Appellants hereby withdraw Claims 1-9, 11-18 and 38-47 from appeal. Accordingly, Appellants' arguments below focus on only Claims 10, 19-22 and 33-37.

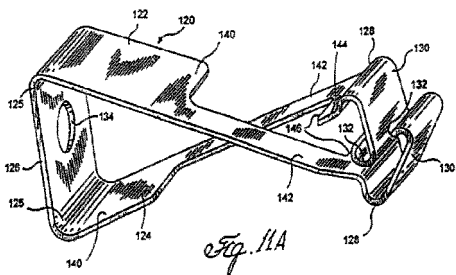
Claim 10

Claim 10 recites:

10. The needle protector clip of claim 1, wherein the first resilient arm and the second resilient arm have arm portions that overlap.

Claim 10 depends from Claim 1, and therefore includes all of the limitations of Claim 1. Claim 1 requires that "the first resilient arm intersects the second resilient arm at their respective second arm sections." Claim 1 further requires that each arm has a first arm section with a first dimension and a second arm section with a second dimension, and the first dimension is larger than the second dimension. Claim 10 introduces an additional limitation that further distinguishes Claim 10 from Kulli in view of Purdy and further in view of Rogalsky. According to Claim 10, not only must the first resilient arm intersect the second resilient arm, but the first resilient arm and the second resilient arm must also have arm portions that overlap.

Claim 10 reads on at least the embodiment of Appellants' clip that is shown in Figures 11A and 11B. For convenience, Figure 11A is reproduced at left. As shown, the clip 120 comprises a first arm 122 and a second arm 124. The arms 122, 124 extend distally from a proximal wall 126. Each arm 122, 124 includes a narrow portion 142 that extends between a proximal wide portion 140 and a distal wide portion 144. The arms intersect one another at their narrow portions 142. Further, distal end walls 130 of the arms 122, 124 overlap.



Neither Kulli nor Purdy nor Rogalsky, nor the combination thereof, teaches or suggests a first resilient arm that intersects a second resilient arm **and** the arms have arm portions that overlap. Figure 3 of Kulli is reproduced below. As Appellants argued in their Brief, Kulli does not teach or suggest a first resilient arm that intersects a second resilient arm. Nevertheless, even assuming for the sake of argument that the opposed transverse shields 24, 26 in Kulli intersect as the Examiner asserts², Kulli still does not teach or suggest a first resilient arm that intersects a second resilient arm **and** the arms have arm portions that overlap. Ex's Ans., para. 10, pg. 7. The separate recitations in Claim 10 of a first resilient arm that intersects a second resilient arm **and** the arms have arm portions that overlap cannot both read on the opposed transverse shields 24, 26 in Kulli. Furthermore, the use of both "overlap" and "intersects" in the same claim implies that these two words have different scopes and meanings.

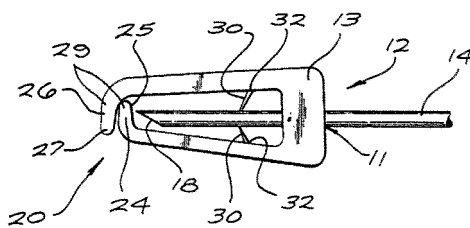
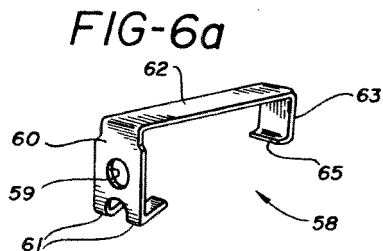


FIG. 3

Figure 6a of Purdy is reproduced below. The Examiner does not assert that Purdy teaches a first resilient arm that intersects a second resilient arm.

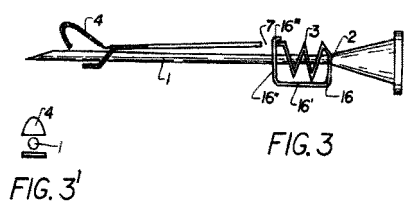


It is clear from an inspection of Figure 6a that in fact Purdy's leaf spring 58 does not include a first resilient arm that intersects a second resilient arm. It is further clear from an inspection of Figure 6a that Purdy's leaf spring 58 also does not include arms

² Appellants strongly oppose this interpretation as being against the grain and contrary to the dictionary definition. The Examiner's distorted position also ignores the well established principle that an applicant may be his own lexicographer.

that have arm portions that overlap.

Figures 3 and 4 of Rogalsky are reproduced below. As Appellants argued in their Brief, Rogalsky does not teach or suggest a first resilient arm that intersects a second resilient arm.



Nevertheless, even assuming for the sake of argument that the “second arm section near 16'/16” intersects ... second arm section member (near element 7)” as the Examiner asserts, Rogalsky still does not teach or suggest a first resilient arm that intersects a second resilient arm **and** the arms have arm portions that overlap. Ex's Ans., para. 10, pg. 7. The separate recitations in Claim 10 of a first resilient arm that intersects a second resilient arm **and** the

arms have arm portions that overlap cannot both read on the “second arm section near 16'/16” [and the] second arm section member (near element 7)” in Rogalsky.

As demonstrated above, the Examiner has not met his burden of presenting a *prima facie* case of obviousness with respect to Claim 10. Accordingly, the Examiner's rejection of Claim 10 over Kulli in view of Purdy and further in view of Rogalsky is unsupported. Appellants respectfully request that the Board reverse the Examiner's rejection of Claim 10.

Claim 19

Claim 19 recites:

19. A needle guard for shielding a needle tip comprising:
a proximal end wall having an opening for receiving a needle therethrough;
first and second arms each comprising a wide section, narrow section, and a distal wall at an end thereof, the first and second arms extending distally from the proximal end wall; and
wherein the first arm intersects the second arm and their respective distal walls overlap.

In Claim 19, the limitation “the first arm intersects the second arm and their respective distal walls overlap” is similar in scope to the limitations of Claim 10 discussed above. Appellants stress, however, that these limitations are not identical in scope. Nevertheless, Claim 19 requires a first arm that intersects a second arm **and** their respective distal walls overlap. As demonstrated above with respect to Claim 10, Kulli in view of Purdy and further in view of Rogalsky does not teach or suggest a first arm that intersects a second arm **and** the arms have

arm portions that overlap. Accordingly, Kulli in view of Purdy and further in view of Rogalsky cannot possibly teach or suggest a first arm that intersects a second arm *and* their respective distal walls overlap.

For the reasons provided above, the Examiner has not met his burden of presenting a
5 *prima facie* case of obviousness with respect to Claim 19. Accordingly, the Examiner's rejection
of Claim 19 over Kulli in view of Purdy and further in view of Rogalsky is unsupported. Claims
20-22 and 33-37 depend from Claim 19 and therefore include all of the features recited therein.
Accordingly, Claims 20-22 and 33-37 are allowable over Kulli in view of Purdy and further in
view of Rogalsky for at least the same reasons as Claim 19, and on their own merit. Appellants
10 respectfully request that the Board reverse the Examiner's rejections of these claims.

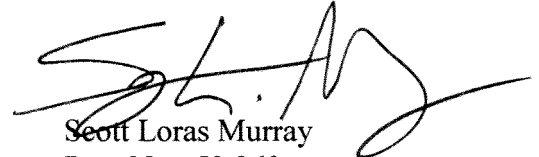
CONCLUSION

In view of the foregoing, and in view of the arguments presented in Appellants' Brief, Appellants respectfully submit that Claims 10, 19-22 and 33-37 are allowable over Kulli in view of Purdy and further in view of Rogalsky. Appellants therefore respectfully request that the
5 Board reverse the Examiner's rejections.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1159.

10 Date: March 2, 2009

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. L. Murray', with a long horizontal flourish extending to the right.

15 Scott Loras Murray
Reg. No.: 53,360
Attorney for Appellants
Tel.: (949) 955-1920